



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

P

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

┌

└

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

3

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/724,380

Applicant(s)

MILES ET AL.

Examiner

David Guzo

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, drawn to a composition that inhibits VAI RNA, classified in class 536, subclass 24.5.
- II. Claims 3-5, 7-10, and 12-17, drawn to a nucleic acid composition for inhibiting viral (rhinovirus) replication comprising a nucleic acid complementary to at least a portion of a viral IRES and methods of inhibiting translation of viral (picornavirus) replication, classified in class 514, subclass 44.
- III. Claims 3, 6, 8-10 and 17, drawn to methods of inhibiting translation of viral (hepatitis A) replication and compositions comprising nucleic acids complementary to at least a portion of a viral IRES, classified in class 514, subclass 44.
- IV. Claims 3, 6, 8-10 and 17, drawn to methods of inhibiting translation of viral (hepatitis C) replication and compositions comprising nucleic acids complementary to at least a portion of a viral IRES, classified in class 514, subclass 44.
- V. Claim 11, drawn to a method of inhibiting translation of hepatitis B virus, classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

Art Unit: 1636

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve distinct nucleic acid compositions wherein the compositions of Group I are specifically designed to inhibit VAI RNA (from adenovirus) while the compositions of Group II are designed to inhibit translation of unrelated viruses containing IRES elements. Each invention is capable of supporting separate patents.

Inventions III, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions involve distinct nucleic acid compositions for inhibiting three different hepatitis viruses which cause three separate diseases in humans. Each invention is capable of supporting a separate patent.

It is noted that claims 3, 8-10 and 17 are generic and will be examined to the extent that they read on the elected subject matter, i.e. if applicants elect Group II, the generic claims will be examined to the extent that they read on compositions for inhibiting rhinovirus replication and methods of inhibiting picornavirus translation. Also, claim 6 is generic (included in Groups III and IV) in that it reads on a method of inhibiting translation of hepatitis A or hepatitis C, i.e. if applicants elect Group III, the generic claims will be examined to the extent that they read on compositions for inhibiting translation of hepatitis A virus and methods of inhibiting hepatitis A translation.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo whose telephone number is (703) 308-1906. The examiner can normally be reached Monday-Thursday on 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Robert Schwartzman can be reached on (703) 308-7307. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding or attachments to this Office Action should be directed to Patent Analyst Zeta Adams whose telephone number is (703) 305-3291.

David Guzo
June 18, 2001

DAVID GUZO
PRIMARY EXAMINER
David Guzo